

No. 5,768,633 (hereinafter "Allen et al. '633"). Applicants believe that these claims are allowable over the cited references for the reasons discussed below.

Claims 12-19 and 21-22 were rejected under 35 U.S.C. §103(a) as being unpatentable over Hildebrandt et al. '514 in view of McCarten et al., U.S. Patent No. 5,959,596 (hereinafter "McCarten et al. '596"). Applicants believe that these claims are allowable over the cited references for the reasons discussed below.

Claim 20 was rejected under 35 U.S.C. §103(a) as being unpatentable over Hildebrandt et al. '514 and McCarten et al. '596 as applied to claim 12, and further in view of Allen et al. '633. Applicants believe that this claim is allowable over the cited references for the reasons discussed below.

Legal Standard for Claim Rejection Under 35 U.S.C. §103

The test for obviousness under 35 U.S.C. §103 is whether the claimed invention would have been obvious to those skilled in the art in light of the knowledge made available by the references. *In re Donovan*, 184 USPQ 414, 420, n. 3 (CCPA 1975). It requires consideration of the entirety of the disclosures of the references. *In re Rinehart*, 189 USPQ 143, 146 (CCPA 1976). All limitations of the claims must be considered. *In re Boe*, 184 USPQ 38, 40 (CCPA 1974). In making a determination as to obviousness, the references must be read without benefit of Applicants' teachings. *In re Meng*, 181 USPQ 94, 97 (CCPA 1974). In addition, the propriety of a §103 rejection is to be determined by whether the reference teachings appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed substitution, combination, or other modifications. *In re Lintner*, 173 USPQ 560, 562 (CCPA 1972). A reference which **teaches away** from the Applicants' invention may not properly be used in framing a

35 U.S.C. §103 rejection of Applicants' claims. See *United States v. Adams*, 148 USPQ 479, 484 (1966).

A basic mandate inherent in §103 is that a piecemeal reconstruction of prior art patents shall not be the basis for a holding of obviousness. It is impermissible within the framework of §103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. *In re Kamm*, 172 USPQ 298, 301-302 (CCPA 1972).

When determining the patentability of a claimed invention which combines two known elements, the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Ecolochem Inc. v. Southern California Edison*, 56 USPQ2d 1065, 1073 (Fed. Cir. 2000). In other words, there must be something in the teachings of cited references to suggest to an individual skilled in the art that a claimed invention would be obvious. *W. L. Gore and Associates v. Garlock, Inc.*, 220 USPQ 303 (Fed. Cir. 1983). This position was reaffirmed in the case of *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 43 USPQ 2d 1294 (Fed. Cir. 1997). *Arkie Lures* involved the combination of a plastic fishing lure with salt materials to yield a highly attractive lure product. The prior art disclosed both concepts (salty bait and plastic lures) separately but not in combination. The CAFC ultimately held that the invention under consideration was not obvious. Even though both of the claimed features were disclosed by the cited art, the CAFC concluded that this was insufficient to prove a case of obviousness in the absence of a teaching or suggestion in the art to combine the references.

Likewise, the requirement that a **concrete suggestion** be present in the cited art for a proper obviousness rejection to be made is even further supported by *C.R. Bard Inc. v. M3 Systems Inc.*, 48 USPQ 2d 1225 (Fed. Cir. 1998). This case involved an allegation that a particular medical needle apparatus was merely a product of “obvious modifications” to a prior needle assembly. The CAFC disagreed and stated that the claimed invention was neither suggested nor taught by the prior art, and further indicated that the “invention that was made, however, does not make itself obvious; **that suggestion or teaching must come from the prior art**” itself. 48 USPQ 2d at 1232 (emphasis added). The CAFC also concluded that the requisite suggestion or teaching was so important that, in its absence, the claimed invention could not have been obvious. According to the court, “Absent this essential evidentiary component of an obviousness holding, as a matter of law the verdicts of invalidity on that ground cannot stand. Consequently, the judgment of invalidity based on obviousness is reversed.” 48 USPQ 2d at 1232.

Rejection of Claims 1-11

As noted above, claims 1-11 were rejected under 35 U.S.C. §103(a) as being unpatentable over Hildebrandt et al. '514 in view of Allen et al. '633. Applicants believe that these claims are allowable over the cited references for the following reasons.

Hildebrandt et al. '514 is directed to a method and apparatus for carrying out passenger-related and flight attendant-related functions in an airplane. On-board functions are performed with the aid of a central control computer (1, Fig. 1; 15, Fig. 6) connected to a plurality of data terminals (14, Fig. 6) which each include an input keyboard (20). The data terminals (14) enable a passenger to perform particular

functions such as making a long-distance telephone call; playing a video game with other passengers; and retrieving information, music, and the like from the central control computer (1, 15).

As noted by the Examiner on page 2 of the Office Action, Hildebrandt et al. '514 does not disclose or suggest "a communications unit comprising [at least] one receiver to receive image data from a digital camera." More specifically, Hildebrandt et al. '514 does not disclose or suggest Applicants' claim 1, with particular emphasis on the underlined elements below:

1. (As amended above) A communications system, comprising:
 - a) a plurality of communications units fixedly mounted onboard an airplane, each of said communications units being adapted to be operated by an associated passenger to perform digital image viewing functions, whereby each of said communications units comprises at least one receiver adapted to receive image data input by said associated passenger from a digital camera and display said image data on a video screen; and
 - b) at least one processor operatively connected to said at least one receiver and said video screen.

Claim 1 was amended above in order to more clearly identify the source of the image data (an "associated passenger"), which was implicit in Applicants' claim 1 prior to amendment thereof and is discussed in Applicants' Specification.

As noted above, the passenger-related input device disclosed by Hildebrandt et al. '514 is a keyboard (20). No other type of passenger input device, and certainly nothing even remotely resembling a "receiver adapted to receive image data input

by [an] associated passenger from a digital camera", is disclosed or suggested by this reference.

Allen et al. '633 is directed to a photographic and data transmission system for use at a trade show. The system includes a wireless communication unit (12, Fig. 1) connected to a personal computer (16). An image of a product, as well as an "extra data" bit which identifies the presence of additional product data along with the image, may be transmitted through the wireless communication unit (12) to a digital camera (22, 28) brought by a trade show visitor (24). The trade show visitor (24) may then download the transmitted image and "extra data" bit from his/her camera (22, 28) to a host computer (74, Fig. 6). The host computer (74) is adapted to sense the "extra data" bit and connect the trade show visitor to a network server (78) in order to obtain more information about the product.

Contrary to Applicants' invention as claimed in claim 1, Allen et al. '633 discloses a single personal computer (16) to be used by many trade show visitors (24). Thus, this reference actually teaches away from providing a plurality of communications units, each of which is to be utilized by an associated person such as an airplane passenger. As noted above, a reference which teaches away from the Applicants' invention may not properly be used in framing a 35 U.S.C. §103 rejection of Applicants' claims. See *United States v. Adams*, 148 USPQ 479, 484 (1966). Furthermore, Allen et al. '633 provides no suggestion that its personal computer (16) could be utilized on a moving vehicle such as an airplane, or that there would be any particular reason to do so. More specifically, Allen et al. '633 does not disclose or suggest Applicants' claim 1, with particular emphasis on the underlined elements below:

1. (As amended above) A communications system, comprising:
 - a) a plurality of communications units fixedly mounted onboard an airplane, each of said communications units being adapted to be operated by an associated passenger to perform digital image viewing functions, whereby each of said communications units comprises at least one receiver adapted to receive image data input by said associated passenger from a digital camera and display said image data on a video screen; and
 - b) at least one processor operatively connected to said at least one receiver and said video screen.

The combination of Hildebrandt et al. '514 and Allen et al. '633 is entirely improper in that there is absolutely no suggestion in either reference that would motivate one skilled in the art to combine these references. There is nothing in Hildebrandt et al. '514 which would suggest that the multiple data terminals (14) with their keyboards (20) could or should be modified to include a receiver adapted to receive image data input by an associated passenger from a digital camera, as well as a processor operatively connected to a receiver and video screen. Furthermore, there is nothing in Allen et al. '633 which would motivate a trade show visitor (24) to take his/her digital camera on an airplane in order to view his/her pictures. There is also nothing in Allen et al. '633 which would motivate one skilled in the art to transfer a wireless communication unit from a trade show personal computer to a plurality of data terminals on an airplane. As noted above, a concrete suggestion must be present in the cited art for a proper obviousness rejection to be made, and that suggestion or teaching must come from the prior art itself. *C.R. Bard Inc. v. M3 Systems Inc.*, 48 USPQ 2d 1225 (Fed. Cir. 1998). However, **neither** Hildebrandt et

al. '514 nor Allen et al. '633 provides the necessary suggestion to combine these references in an attempt to produce Applicants' claimed invention. For at least this reason, Applicants' claim 1 is believed to be allowable over the cited references.

Claims 2-11, which are each directly or ultimately dependent on claim 1, are believed to be allowable as depending from an allowable base claim, and also because of the novel and nonobvious combination of elements disclosed therein.

Rejection of Claims 12-19 and 21-22

As noted above, claims 12-19 and 21-22 were rejected under 35 U.S.C. §103(a) as being unpatentable over Hildebrandt et al. '514 in view of McCarten et al. '596. Applicants believe that these claims are allowable over the cited references for the following reasons.

As noted by the Examiner on page 4 of the Office Action, Hildebrandt et al. '514 does not disclose or suggest "a communications system [comprising] a scanner adapted to scan a document and display a scanned image of said document on a video screen; and at least one processor operatively connected to said scanner and said video screen." More specifically, Hildebrandt et al. '514 does not disclose or suggest Applicants' claim 12, with particular emphasis on the underlined elements below:

12. (As amended above) A communications system, comprising:

- a) a plurality of communications units fixedly mounted onboard an airplane, each of said communications units being adapted to be operated by an associated passenger to perform scanning functions, whereby each of said communications units comprises a scanner adapted to scan a document

provided by said associated passenger and display a scanned image of said document on a video screen;

b) at least one processor operatively connected to said scanner and said video screen; and

c) at least one remote connection device adapted to connect each of said communications units to a remote location.

Claim 12 was amended above in order to more clearly identify the source of the document to be scanned (an “associated passenger”), which was implicit in Applicants’ claim 12 prior to amendment thereof and discussed in Applicants’ Specification.

As noted above, the passenger-related input device disclosed by Hildebrandt et al. ‘514 is a keyboard (20). No other type of passenger input device, and certainly nothing even remotely resembling a “scanner adapted to scan a document provided by [an] associated passenger” is disclosed or suggested by this reference.

McCarten et al. ‘596 is directed to an airline-based video game and communications system. The system includes a magnetic card reader (88, Fig. 4) which is used to read information magnetically stored on the magnetic strip of a user’s credit card.

McCarten et al. ‘596 does not disclose or suggest providing a scanner adapted to scan a document provided by an associated passenger. A credit card is not equivalent to a document for many reasons, including the important fact that information is stored magnetically on a credit card, while information (words, graphics and other indicia) is typed, printed, or hand-written on a document. Among other differences, magnetically-stored information on a credit card is not visible, as is

information on a document. Furthermore, a magnetic card reader is not equivalent to a scanner in that they perform entirely different functions: a magnetic card reader reads magnetically-stored information from a credit card, while a scanner optically scans visible indicia on a document.

Therefore, McCarten et al. '596 does not disclose or suggest Applicants' claim 12, with particular emphasis on the underlined elements below:

12. (As amended above) A communications system, comprising:

- a) a plurality of communications units fixedly mounted onboard an airplane, each of said communications units being adapted to be operated by an associated passenger to perform scanning functions, whereby each of said communications units comprises a scanner adapted to scan a document provided by said associated passenger and display a scanned image of said document on a video screen;
- b) at least one processor operatively connected to said scanner and said video screen; and
- c) at least one remote connection device adapted to connect each of said communications units to a remote location.

The combination of Hildebrandt et al. '514 and McCarten et al. et al. '596 could possibly produce a plurality of data terminals each having a magnetic card reader, but it would not produce Applicants' invention as claimed in claim 12. For at least this reason, Applicants believe that claim 12 is allowable over the cited references.

Claims 13-19, which are each directly dependent on claim 12, are believed to be allowable as depending from an allowable base claim, and also because of the novel and nonobvious combination of elements disclosed therein.

With regard to Applicants' claim 21, the Examiner states the following on page 6 of the Office Action: "the claim differs from claim 12 only by the additional limitation 'one remote connection device adapted to connect said communications units to a remote location'." Applicants wish to point out that claim 12 also contains the above-quoted element. Actually, claim 21 is essentially a combination of Applicants' claims 1 and 12 in that it includes **both** "at least one receiver adapted to receive image data input by said associated passenger from a digital camera and display said image data on a video screen" and "a scanner adapted to scan a document provided by said associated passenger and display a scanned image of said document on a video screen" (Applicants' claim 21, elements ai and aii). Claim 21 was amended above in order to more clearly identify the source of the image data and the document to be scanned (an "associated passenger"), which was implicit in Applicants' claim 21 prior to amendment thereof and discussed in Applicants' Specification. The above arguments relative to the allowability of Applicants' claims 1 and 12 are herein renewed and applied to Applicants' claim 21. For the same reasons, Applicants believe that claim 21 is allowable over the cited references.

With regard to Applicants' claim 22, the Examiner states the following on page 6 of the Office Action: "the claim differs from claim 12 only by the additional limitation 'one receiver adapted to receive image data from a digital camera and display said image data on a video screen'." Similar to claim 21, claim 22 actually includes **both** "at least one receiver adapted to receive image data input by an

associated passenger from a digital camera and display said image data on a video screen” and “a scanner adapted to scan a document provided by an associated passenger and display a scanned image of said document on a video screen” (Applicants’ claim 22, elements ai and `aii). Claim 22 was amended above in order to more clearly identify the source of the image data and the document to be scanned (an “associated passenger”), which was implicit in Applicants’ claim 22 prior to amendment thereof and discussed in Applicants’ Specification. The above arguments relative to the allowability of Applicants’ claims 1, 12 and 21 are herein renewed and applied to Applicants’ claim 22. For these same reasons, Applicants believe that claim 22 is allowable over the cited references.

Rejection of Claim 20

As noted above, claim 20 was rejected under 35 U.S.C. §103(a) as being unpatentable over Hildebrandt et al. ‘514 and McCarten et al. ‘596 as applied to claim 12, and further in view of Allen et al. ‘633. Applicants believe that this claim, which is dependent on claim 12, is allowable as depending from an allowable base claim, and also because of the novel and nonobvious combination of elements disclosed therein.

Conclusion

For at least the reasons discussed above, Applicants believe that all of the pending claims (claims 1-22) are allowable over the cited references. Therefore, Applicants respectfully request that the Examiner reconsider the application and grant an early allowance.

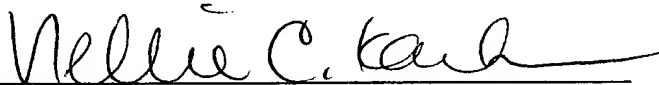
An Appendix in compliance with 37 C.F.R. §1.121 containing a marked-up version of the amendments made to the claims follows this page.

Should there be any questions regarding this Amendment, the Examiner may contact Applicants' attorney at the telephone number listed below.

Respectfully submitted,

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APPENDIX

Submitted herewith in compliance with 37 C.F.R. §1.121 is a marked-up version of the amendment made to the claims of the above-identified patent application. Additions are indicated by underlining, and deletions are shown in brackets.

In the Claims

Claim 1 has been rewritten as follows:

1. (Once amended) A communications system, comprising:
 - a) a plurality of communications units fixedly mounted onboard an airplane, each of said communications units being adapted to be operated by an associated passenger to perform digital image viewing functions, whereby each of said communications units comprises at least one receiver adapted to receive image data input by said associated passenger from a digital camera and display said image data on a video screen; and
 - b) at least one processor operatively connected to said at least one receiver and said video screen.

Claim 12 has been rewritten as follows:

12. (Once amended) A communications system, comprising:
 - a) a plurality of communications units fixedly mounted onboard an airplane, each of said communications units being adapted to be operated by an associated passenger to perform scanning functions, whereby each of said communications units comprises a scanner adapted to scan a document

provided by said associated passenger and display a scanned image of said document on a video screen;

b) at least one processor operatively connected to said scanner and said video screen; and

c) at least one remote connection device adapted to connect each of said communications units to a remote location.

Claim 21 has been rewritten as follows:

21. (Once amended) A communications system, comprising:

a) a plurality of communications units fixedly mounted onboard an airplane, each of said communications units being adapted to be operated by an associated passenger to perform digital image viewing and scanning functions, whereby each of said communications units comprises:

i) at least one receiver adapted to receive image data input by said associated passenger from a digital camera and display said image data on a video screen; and

ii) a scanner adapted to scan a document provided by said associated passenger and display a scanned image of said document on a video screen;

b) at least one processor operatively connected to said at least one receiver, said scanner, and said video screen; and

c) at least one remote connection device adapted to connect said communications units to a remote location.

Claim 22 has been rewritten as follows:

22. (Once amended) A communications system, comprising:

- a) a plurality of communications units fixedly mounted onboard an airplane, each of said communications units comprising:
 - i) at least one receiver adapted to receive image data input by an associated passenger from a digital camera and display said image data on a video screen; and
 - ii) a scanner adapted to scan a document provided by an associated passenger and display a scanned image of said document on a video screen; and
- b) at least one processor operatively connected to said at least one receiver, said scanner, and said video screen.